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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,107	04/08/2004	Boris Mayer	30691/DP011	8993
4743	7590	03/07/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			BANGACHON, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,107

Applicant(s)

MAYER ET AL.

Examiner

William L. Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, the abstract is objected to because it recites, "**Disclosed herein**".
2. The "**Detailed Description of Invention**" is objected to because the description does not contain any reference to the drawings, which would help facilitate in the understanding of the invention. Correction is required. See MPEP § 608.01(g).

608.01(g) Detailed Description of Invention

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by 37 CFR 1.71, MPEP § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. The Examiner, however, should require necessary grammatical corrections, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification. **Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations. The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims.** See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and § 1302.01. For completeness, see MPEP § 608.01(p).

Drawings

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3. The drawings are objected to because when there are drawings, there shall be a brief description of the several views of the drawings and **the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter)**. See 37 CFR 1.74.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **“operating unit, plurality of electronic parcel boxes, control unit, malfunctioning operating unit, several electronic parcel box systems networked with each other, central database server, memory, transmitter, device for delivering postal parcels”** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the Examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-3, it is unclear how the parcel boxes are associated with the operating unit, the control unit interface, malfunctioning operating unit, and with another operating unit. It is unclear how the different elements interact with the parcel boxes.

With regards to claim 3, it is unclear whether the recitation "**according to claim 1**" includes all the limitations of claims 1 and 2, including the recited elements and how the different elements are associated.

Claim 3 recites the limitation "**several electronic parcel box systems networked with each other**" in page 13. There is insufficient antecedent basis for this limitation in the claim.

Finally, with regards to claims 3, the "device" is lacking the necessary cooperative structural relationship among the elements in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,456,900 {Kakuta}.

With regards to claim 1, Kakuta teach of an electronic parcel box system (Please refer to Figures 1-5) comprising:

(a) an operating unit 120;

(b) a plurality of electronic parcel boxes 101, several of which are associated with the operating unit; and,

(c) a control unit 110 for controlling the operating unit 120, the control unit 110 comprising an interface 111-113 for flexibly associating the parcel boxes with the operating units {col. 7, lines 45+}.

Alternatively, Kakuta does not disclose expressly an electronic parcel box, it would have been obvious to one of ordinary skill in the art that most lockers are shaped like boxes, and the locker 101 of Kakuta is shaped like one as shown in the drawings.

In claim 2, although Kakuta do not disclose “the parcel boxes associated with a malfunctioning operating unit are associated with another operating unit”, it would have been obvious to one of ordinary skill in the art, that when an operating unit malfunctions, then parcel boxes should be associated with functioning operating units, which is done by either repairing the malfunctioning unit or replacing it with an operating unit that is functioning properly.

Claim 3 recites the limitations of claim 1, further comprising:

(a) several electronic parcel box systems networked with each other according to claim 1. See Figure 7.

(b) a central database server 202 comprising memory 236 for storing data about the filling status of the parcel box systems and a transmitter 232 for transmitting the data; and,

(c) a device 200 for delivering postal parcels to individual electronic parcel box systems as a function of the filling status of the electronic parcel box systems.

Although Kakuta does not disclose expressly "postal parcels", the system of Kakuta is a general-purpose locker and it would have been obvious to one of ordinary skill in the art to use the system of Kakuta for delivery of postal parcels.

12. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/00069 A2 {Stevens et al}.

With regards to claim 1, Stevens et al teach of an electronic parcel box system (abstract) comprising:

- (a) an operating unit (postal storage box) 10 shown in Figures 1, 2 and 8;
- (b) a plurality of electronic parcel boxes 50 shown in Figure 8, several of which are associated with the operating unit via barcode 52; and,
- (c) a control unit 22 for controlling the operating unit 10 (lock state), the control unit 22 comprising an interface 16 for flexibly associating (inputting parcel info) the parcel boxes with the operating units 10.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00069 A2 {Stevens et al}.

In claim 2, although Stevens do not disclose "the parcel boxes associated with a malfunctioning operating unit are associated with another operating unit", it would have been obvious to one of ordinary skill in the art, that when an operating unit malfunctions, then parcel boxes should be associated with functioning operating units, which is done

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by either repairing the malfunctioning unit or replacing it with an operating unit that is functioning properly.

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00069 A2 {Stevens et al} in view of USP 6,456,900 {Kakuta}.

Claim 3 recites the limitations of claim 1, further comprising:

(a) several electronic parcel box systems linked (networked) with each other according to claim 1. See Figure 2.

Although Stevens et al teach of networking the electronic parcel boxes, Stevens do not disclose the elements recited in (b) and (c). In this case, Kakuta is relied upon to teach;

(b) a central database server 202 comprising memory 236 for storing data about the filling status of the parcel box systems and a transmitter 232 for transmitting the data; and,

(c) a device 200 for delivering postal parcels to individual electronic parcel box systems as a function of the filling status of the electronic parcel box systems.

The systems of Stevens and Kakuta are analogous art because they are from same field of endeavor, parcel delivery systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the system of Stevens to implement a supervisory system, because it allows for reliably placing orders and delivery of merchandise to a customer through electronic means, such as the internet, as taught by Kakuta {Kakuta, col. 1, lines 6-21}.

Office Contact Information

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached on 4/4/10.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Horabik can be reached on **(571)-272-3068**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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William L Bangachon
Examiner
Art Unit 2635

February 23, 2006

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